

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Final Office Action dated July 21, 2010 (hereinafter the "Final Office Action"). This paper is submitted with a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114.

I. STATUS OF CLAIMS

Claims 1 and 10 are currently amended.

Claims 2-7, 13-16, 18-33, 37, 39 and 45 are canceled.

Claims 34-36, 38, 40 and 41 stand withdrawn.

Claims 1, 8-12, 17, 34-36, 38, 40-44 and 46-49 are pending.

II. CLAIM OBJECTION

In the Final Office Action claim 45 is objected to, however that objection is now rendered moot by cancellation of claim 45.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e) - SUGIURA

In the Final Office Action, claims 1, 8-11, 17, 45, 48 and 49 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Sugiura (U.S. Pat. Pub. No. 2004/0115550, hereinafter "*Sugiura*"). Applicants respectfully submit that this ground of rejection is based on a misreading or misconstruction of claim 1, as previously presented, and of *Sugiura*. *Sugiura* discloses a dry toner composition designed for use in dry toner printers, whereas Applicants' claim 1, as previously presented and as currently amended, is drawn to a matte liquid toner composition suitable for use in a liquid toner printer. In paragraph [0152] *Sugiura* expressly states that the disclosed toner is dry toner. This is also apparent at paragraph [0129] of *Sugiura* where liquids are used as a medium to deliver pigments to the toner, after which the liquid is removed (line 9). It is apparent that liquids are not part of *Sugiura's* toner composition. Furthermore, additive particles are not in the toner particles of *Sugiura*, but are merely mixed with dry toner particles to form the *Sugiura's* dry toner.

In contrast, Applicants' specification describes a first step in which the toner particle material (varnish) is made in a way that causes the additive particles to be included in the toner particles (p. 13, l. 24 – p. 14, l. 2). In a second step (p. 14, l. 21-31) the varnish (with additives) is placed in an attritor and ground to

form the toner solids which are then suspended in a carrier liquid (e.g., Marcol 82) to form the liquid toner used in a liquid toner printer. The resin and additives mixture described in the first step (varnish making) is not the final liquid toner composition. It appears that the comments on pg. 5 of the Final Office Action ("*the instant specification shows that the dispersion is formed by mixing*") confuse Applicants' step of resin and additives to make the varnish material, with the subsequent step of mixing of the varnish material with carrier liquid to form the final liquid toner mixture.

Claim 1 is currently amended to recite that the additive particles, which are in the toner particles, do not melt or solvate at a surface temperature of an intermediate transfer member during printing, when the matte liquid toner is used for printing in a liquid toner printer. Support for this amendment is found at p. 10, ll. 14-18; p. 3, ll. 5-7; and p. 4, l. 17, for example, of the specification. As amended, claim 1 clearly differs from the dry toner of *Sugiura*. For at least the foregoing reasons the liquid toner of claims 1, 8-12, 17, 45, 48 and 49 distinguishes over the dry toner of *Sugiura*.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e)/103(a) - SUGIURA

In the Final Office Action, claims 12, 46 and 47 are rejected under 35 U.S.C. § 102(e) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as being obvious over *Sugiura*. The Final Office Action states that, "When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67,205 USPQ 594 (CCPA 1980)," citing MPEP §§ 2112 - 2112.02.

Applicants respectfully submit that claims 12, 46 and 47 depend from claim 1 and therefore include all of the limitations of claim 1. As noted by Applicants in Section III, above, *Sugiura* fails to teach all limitations of claim 1 because *Sugiura* discloses a dry toner for use in dry toner printers, not a liquid

toner containing a carrier liquid. Furthermore, additive particles are not in the toner particles of *Sugiura*. One of ordinary skill in the art at the time of the invention would have understood that dry toners are formulated differently than liquid toners which are used in liquid toner printers. Any teaching by *Sugiura* regarding thermoplastic resins and their melt flow index does not make up for the aforesaid failings of *Sugiura* as to liquid toner and carrier liquid, and additive particles in the toner particles. Even if a thermoplastic resin described by *Sugiura* were used in the matt liquid toner of claim 12, a person having ordinary skill in the art at the time of the invention would have understood that the melting/flowing point for liquid and dry toners are different, with the liquid lowering the "flowing point" compared to dry toner, and thus permitting liquid toners to have a different processing and fixing process and temperatures. For at least these reasons, claims 12, 46 and 47 are not anticipated by, and are nonobvious over, *Sugiura*.

V. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a) - SUGIURA AND NAKAMURA

In the Final Office Action, claims 42-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sugiura* as applied to claim 1 and in view of Nakamura (U. S. Patent No. 6,210,852; hereinafter "*Nakamura*"). *Sugiura* fails to teach or suggest all limitations of parent claim 1, as discussed above. Even if, *arguendo*, the 3-50 μm size polyethylene wax particles of *Nakamura* were used as the wax additive of *Sugiura*, the skilled person would have understood that both *Nakamura* and *Sugiura* use wax as an additive mixed with toner particles to promote full transfer to the substrate. *Nakamura* refers to wax as an imparting agent (col. 7, ll. 37-39) to prevent offset of the toner. Among other differences, there is no teaching or suggestion in *Nakamura* of forming toner particles such that the wax particles are included in the toner particles, as required in parent claim 1. For at least this reason, claims 42-44 are not obvious over the combined teaching of *Sugiura* and *Nakamura*.

VI. OTHER AMENDMENTS

Claim 10 is currently amended to recite that the additive particles "comprise up to 50%" instead of "make up at least 40%" by weight of the toner particles. Support for this amendment is at pg. 14, lines 5-6, for example, in the specification.

VII. REQUEST FOR REJOINDER OF WITHDRAWN CLAIMS

The withdrawn claims of Group III (claims 34-36, 38 and 40-41) depend directly or indirectly from claim 1 and incorporate all of the limitations thereof. As claim 1 is patentable over the cited reference for at least the reasons stated above, unity of invention exists between elected Group I and withdrawn Group III. Consistent with the Decision on Petition mailed September 21, 2009, Applicants request withdrawal of the restriction requirement as to Group III. Claims 34-36, 38 and 40-41 are patentable over the cited references for at least the same reasons as stated above regarding claim 1.

VIII. CONCLUSION

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and withdrawal of the rejections and allowance of all pending Group I and Group III claims in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper.

Appl. No. 10/585,681
Amdt. dated October 19, 2010
Reply to Final Office Action of July 21, 2010

However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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